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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,186	10/27/2000	Sigeyuki Yokoyama	04853.0048	4446

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EXAMINER

KERR, KATHLEEN M

ART UNIT PAPER NUMBER

1652

DATE MAILED: 05/30/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/697,186

Applicant(s)

YOKOYAMA ET AL.

Examiner

Kathleen M Kerr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Application Status

1. In response to the Notice to Comply with the sequence rules (Paper No. 9 mailed March 26, 2002), Applicants filed a preliminary amendment (Paper No. 10 received April 11, 2002) containing a sequence listing in computer readable form (CRF) and paper copy. Said amendment has been entered. Claims 1-9 are pending in the instant application.

Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:
- I. Claims 1-3, drawn to mutant kanamycin nucleotidyltransferases, classified in class 435, subclass 193.
 - II. Claims 4-7, drawn to genes encoding mutant kanamycin nucleotidyltransferases, classified in class 536, subclass 23.2.
 - III. Claims 8-9, drawn to methods of screening bacteria using genes encoding mutant kanamycin nucleotidyltransferases, classified in class 435, subclass 15.

3. The inventions are distinct, each from the other because of the following reasons:

The DNA of Group II is related to the enzymes of Group I by virtue of the fact that the DNA encode the enzymes. The DNA molecule has utility for the recombinant production of the enzyme in a host cell. Although the DNA and the enzyme are related, they are distinct inventions because the enzyme product can be made by other and materially distinct processes, such as purification from a natural source. Furthermore, DNA can be used for processes other

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than the production of enzyme, such as nucleic acid hybridization assays. Therefore, Groups I and II are patentably distinct. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (M.P.E.P. § 806.04, M.P.E.P. § 808.01). In the instant case, the enzymes of Group I are not used in the methods of Group III. Moreover, the mutant enzyme and the screening methods have wholly different functions and/or modes of operations. Thus, Groups I and III are patentably distinct. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case, the DNA can be used for a materially different process of using that product, such as in the production of the recombinant enzyme for in vitro studies. Thus, Groups II and III are patentably distinct. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Notice of Possible Rejoinder

4. The Examiner notes that if claims in Group II are found directed to an allowable product, then in Group III, which are directed to processes of using the patentable product, previously withdrawn from consideration as a result of a restriction requirement, would now be rejoined pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also M.P.E.P. § 821.04, *In re* Ochiai, and *In re* Brouwer). Since process claims would be rejoined and fully examined for patentability under 37 C.F.R. § 1.104, Applicants are instructed to amend said claims as deemed necessary according to rejections made against the elected claims.

Conclusion

5. Applicants must elect an invention (Group) to be examined in response to the instant Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229.

The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 305-3014 for After Final communications.

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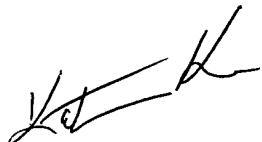
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KMK

May 20, 2002

A handwritten signature in black ink, appearing to be 'KMK', written over the typed name and date.